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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/912,779
Filing Date: July 25, 2001
Appellant(s): KARIDIS ET AL.

MAILED
AUG 26 2005
Technology Center 2600

Robert A. Voigt, Kelly K. Kordzik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 21, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The brief does not contain a statement of the status of all the claims, pending or canceled, and identify the claims appealed as required by 37 CFR 1.192(c)(3). This missing claim 1 status.

(4) *Status of Amendments After Final*

The brief does not contain a statement of the status of an amendment filed subsequent to the final rejection as required by 37 CFR 1.192(c)(4). The Amendment after final dated May 25, 2005 has been entered.

(5) *Summary of Invention*

The copy of appeal contains statements of "summary of claimed subject matter". The summary of claimed subject matter contained in the brief is correct.

(6) *Issues*

The brief does not contain a concise statement of the issues presented for review as required by 37 CFR 1.192(c)(6). Weather claim 13 is unpatentable under U.S.C. 103 over Takahashi (Takahashi U. S. Patent 6,662,244) in view of Novis (Novis et al. U. S. Patent 5,867,795).

(7) *Grouping of Claims*

No statement of grouping of claims in the brief. One claim only stands rejected.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,662,244	Takahashi	7-2000
5,867,795	Novis et al.	8-1996
5,436,954	Nishiyama et al.	7-1993
6,708,046	Takagi	9-2000

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claim:

Claim 13 rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 4/20/2005.

(Note: The office action is not restructured; however, it has been edited for clarity. The same references have been used against the same limitations in claim 13.)

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) Patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

1. Claim 13 is rejected under 35 U.S.C.103(a) as being unpatentable over Takahashi (Takahashi U. S. Patent 6,662,244) in view of Novis (Novis et al. U. S. Patent 5,867,795).

Regarding claim 13, Takahashi discloses a personal communication device comprising a dual mode display for a user's viewing in both (*see for example, Figures 3-4 and 10, column 1, lines 6-14, column 4, lines 35-39, column 5, lines*

23-27, the information terminal (personal communication device) having two states (dual mode)) a direct-view mode (see for example, Figure 4, column 4, line 58-67, and column 5, lines 23-27, the user viewing in both states (modes), the closed states (direct-view) and open state (projection-view)), wherein sufficiently-sized characters are displayed in a manner visible to the user (see for example, Figure 4, column 4, line 58-67, column 5, lines 23-27, the information (sufficient-sized characters) displayed on the display section (Figure 4(5)) is clearly visible to the user in a manner without magnification), and in "projection-view" mode (see for example, Figure 10, column 4, lines 34-39, and line 46-57, the open state (projection-view)), wherein more content can be displayed over that of the direct-view mode (see for example, Figures 4 and Figure 10, column 4, more information (content) is displayed in open state (projection-view) than of the closed mode (direct-view mode)).

Takahashi does not specifically teach magnification.

In a related art dealing with personal communication device (see for example, column 1, lines 1-19), Novis teaches magnification (see for example, Figure 11, column 8, lines 31-39, the characters magnification).

It would have been obvious to one of ordinary skill in the art at the time invention was made to include Novis' device optical lens set with Takahashi's "portable information terminal of wireless communication system" (column 1, lines 10-11) to provide "a portable electronic device including a visual image display" that contains safe features to prevent unwarranted viewing and easy to

operate, and displays enlarged size characters (Novis, column 2, lines 14-15, and lines 30-38, column 8, lines 31-39).

Allowable Subject Matter

2. Claims 1, 3-8, and 10-12 are allowed.
3. Claim 14 is objected.

(11) Response to Arguments

With respect to rejection of claim 10 as being unpatentable over Takahashi (Takahashi U. S. Patent 6,662,244) in view of Novis (Novis et al. U. S. Patent 5,867,795).

A. The Appellant argues that claim 13 is not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi in view of Novis as follows:

1. The Appellant argues (page 3, line 11, through page 6, line 2) the motivation for combining Takahashi with Novis as applied to claim 13. The Examiner's response is as follows:

The Appellant argues (page 3, line 16, through page 4, line 2) by first describing a "*prima facie*", "showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all

of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions", and referencing the M.P.E.P §2142 and referring to the case laws.

In response to the Appellant's citation of case law, the Examiner has no argumentative response to evaluating the art in such a manner as described in the case laws, however, a "*prima facie*" showing the obviousness and is "*inter alia*" is being established, both of the references are from the same class (455/566) of wireless communication devices with display, and motivation to combine Takahashi with Novis follows from the references themselves, and the motivation to combine is not looking at the Appellant's disclosure nor the Examiner's assumption. The factual evidence establishing the level of skill of the ordinary artisan is clearly provided by Novis device optical lens set is a design consideration. The Examiner maintain that would have been one of ordinary skill in the art, at the time the invention was made to include Novis' device optical lens set with Takahashi's "portable information terminal of wireless communication system" (column 1, lines 10-11) to provide "a portable electronic device including a visual image display" that contains safe features to prevent unwarranted viewing and easy to operate, and displays enlarged size characters that is not going to need further magnification (Novis, column 2, lines 14-15, and lines 30-38, column 8, lines 31-39).

The Appellant argues (page 4, line 3, through page 4, line 10) that the Examiner

admits that Takahashi does not teach "wherein sufficiently-sized characters are displayed in a manner visible to the user without further magnification" as recited in claim 13. Paper No. 7, page 3. The Examiner modifies Takahashi with Novis to include the above-cited claim limitation "to provide a portable electronic device including a visual image display that contains safe features to prevent unwarranted viewing and easy to operable, and displays enlarged sized characters that is not going to need further magnification (Novis, column 2, lines 14-15, and lines 30-38, column 8, lines c 1-39)." Paper No. 7, pages 3-4.

In response to the Appellant, the Examiner did not admit that Takahashi does not teach, "wherein sufficiently-sized characters are displayed in a manner visible to the user without further magnification" as recited in claim 13. As evidence, the Examiner pointing to the last office action (April 17, 2005), on page 3, line 10, that "Takahashi does not specifically teach magnification". Lacking the "magnification" is not the same as "wherein sufficiently-sized characters are displayed in a manner visible to the user without further magnification". This limitation is being taught by Takahashi (see for example, Takahashi, Figure 4, column 4, line 58-67, column 5, lines 23-27) and office action (April 17, 2005; page 3, lines 2-5).

The Appellant argues (page 4, line 11, through page 4, line 19) that The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation does not address as to why one of ordinary skill in the art

with the primary reference (Takahashi) in front of him would have been motivated to modify Takahashi with the teachings of the secondary reference (Novis). The Examiner's motivation appears to be motivation to solve the problem in Novis but not motivation for modifying Takahashi to display sufficiently-sized characters in a manner visible to the user without further magnification in a direct-view mode, as required to establish a *prima facie* case of obviousness. M.P.E.P. §2143.

In response to the Appellant argument, the Examiner disagrees as follows: The motivation is sufficient to support a *prima facie* case of obviousness. Takahashi and Novis, both are discussing portable devices with displays, therefore the references are analogues. Further, Novis suggests in the Background and Summary magnification is necessary so, there is motivation and reasons to combine. The motivation to combine Takahashi with Novis follows from the references themselves, and the motivation to combine is not looking at the Appellant's disclosure, nor the Examiner's assumption. The factual evidence establishing the level of skill of the ordinary artisan is clearly provided by Novis device optical lens set is a design consideration. The Examiner maintain that would have been one of ordinary skill in the art, at the time the invention was made to include Novis' device optical lens set with Takahashi's "portable information terminal of wireless communication system" (Takahashi, column 1, lines 10-11) to provide "a portable electronic device including a visual image display" that contains safe features to prevent unwarranted viewing and easy to operate, and displays enlarged size characters that is not going to need further magnification (Novis, column 2, lines 14-15, and lines 30-38, column 8, lines

31-39).

Further, the Appellant's main argument (page 4, line 20, through page 6, line 2) first, is describing the secondary reference, Novis in a manner to overcome the rejections by selectively pointing to issues such as "Novis teaches that there exists a need to integrate a smart card interface" or referring to the background section of Novis listing some of the problems that could be solved, and next, the motivation for combining Takahashi with Novis.

In response to the Appellant argument, the Examiner disagrees as follows: Novis' teachings are directly dealing with wireless personal communication device (see for example, Figure 1, column 1, lines 1-19), Novis is to modify Takahashi's wireless device, as stated in the above paragraph, that both of the references are from the same class (455/566) of wireless communication devices with display, and motivation to combine Takahashi with Novis follows from the references themselves, and the motivation to combine is not looking at the Appellant's disclosure nor the Examiner's assumption. The factual evidence establishing the level of skill of the ordinary artisan is clearly provided by Novis device optical lens set is a design consideration. The Examiner maintain that would have been one of ordinary skill in the art, at the time the invention was made to include Novis' device optical lens set with Takahashi's "portable information terminal of wireless communication system" (Takahashi, column 1, lines 10-11) to provide "a portable electronic device including a visual image display" that contains safe features to prevent unwarranted viewing

and easy to operate, and displays enlarged size characters that is not going to need further magnification (Novis, column 2, lines 14-15, and lines 30-38, column 8, lines 31-39).

For the above reasons, the Examiner disagrees with the Appellant, and contends that the references are analogous, and there is motivation to combine the references.

B. The Appellant argues that Takahashi and Novis do not teach claim 13 limitations as follows:

The Appellant argues (page 6, line 3, through page 9, line 11) that the Takahashi and Novis, singly or in combination, do not teach or suggest "a personal communication device comprising a dual mode display for a user's viewing in both a direct-view mode, wherein sufficiently-sized characters are displayed in a manner visible to the user without further magnification, and in "projection-view" mode, wherein more content can be displayed over that of the direct-view mode", and further discussing the Takahashi and Novis references in a manner to over come the rejection.

In response to the Appellant argument, the Examiner disagrees as follows: Takahashi teaches a foldable personal communication device with the display (see Figures 3, and 4), the user's viewing the display in both closed and open position and the displayed information (including characters) can be directly viewed in both

positions (as discussed in the above office action), and further more content can be displayed over the display as when in directly viewing. The Appellant argues (page 7, lines 22-26) that Takahashi in the closed state the display section becomes transparent and the user can see the information on the display and in the closed state the same amount of content displayed as in the open state. However, the Examiner like to point out, further, Takahashi teaches that in the information can be displayed in the opposite side that is larger display when it is in direct view. And, further, the Appellant argues the need for using the Novis as second reference, and the combining the two references. The Examiner disagrees as follows: Novis' teachings are directly dealing with wireless personal communication device (see for example, Figure 1, column 1, lines 1-19), and the Examiner has no need to solve any problem nor Novis has any problem to be solved, the secondary reference, Novis is to modify Takahashi's wireless device, as stated in the above paragraph, that both of the references are from the same class (455/566) of wireless communication devices with display, and motivation to combine Takahashi with Novis follows from the references themselves, and the motivation to combine is not looking at the Appellant's disclosure nor the Examiner's assumption. The factual evidence establishing the level of skill of the ordinary artisan is clearly provided by Novis device optical lens set is a design consideration. The Examiner maintain that would have been one of ordinary skill in the art, at the time the invention was made to include Novis' device optical lens set with Takahashi's "portable information terminal of wireless communication system" (Takahashi, column 1, lines 10-11) to

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provide "a portable electronic device including a visual image display" that contains safe features to prevent unwarranted viewing and easy to operate, and displays enlarged size characters that is not going to need further magnification (Novis, column 2, lines 14-15, and lines 30-38, column 8, lines 31-39).

For the above reasons, the Examiner disagrees with the Appellant, and contends that the limitations of claim 13 are taught by the references and there is motivation to combine.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Shaima Q. Aminzay

Examiner

Art Unit 2684

SA
August 22, 2005

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